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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/051,749

01/14/2002

Michael Vajdy

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CHIRON CORPORATION
Intellectual Property - R440
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EXAMINER

LE, EMILY M

ART UNIT	PAPER NUMBER
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1648

MAIL DATE	DELIVERY MODE
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10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/051,749

Applicant(s)

VAJDY ET AL.

Examiner

Emily Le

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-30 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 22-28 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-17, 19-21, 29-30, 35-39 and 41-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2007 has been entered.

Status of Claims

2. Claims 18 and 31-34 are cancelled. Claims 35-42 are added. Claims 1-17, 19-30 and 35-42 are pending. Claims 6-7 and 22-28 are withdrawn from examination for being directed to a nonelected invention. Additionally, claim 40 is also withdrawn from examination for being directed to a nonelected species, wherein Applicant has elected HIV as the antigen for examination in Applicant's April 05, 2004 reply. Claims 1-5, 8-17, 19-21, 29-30, 35-39 and 41-42 are under examination.

Claim Rejections - 35 USC § 102

3. In response to the anticipation rejection(s), Applicant amended the claims to require the composition being administered to comprise a detoxified bacterial ADP-ribosylating toxin. Because of this amendment, the anticipation rejection(s) is withdrawn and obviousness rejection(s) are entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 8-14, 16-17, 19-21, 29-30, 35-39 and 41-42 are rejected under 35 U.S.C. 103(a) as being obvious over Malone et al.¹ in view of O'Hagan et al.²

The claims are directed to a method of generating an immune response in a subject comprising mucosal administration of a composition comprising a detoxified bacterial ADP-ribosylating toxin and a replication defective gene delivery vehicle comprising a polynucleotide encoding at least one antigen. Claims 2-4, which depend on claim 1, require the mucosal administration be intranasal, intrarectal and intravaginal, respectively. Claim 5, which depends on claim 1, requires the antigen be derived from a sexually transmitted pathogen, which is limited to a virus by claim 8. Claims 9 and 10 limit the virus to HIV-1. Claim 11, which depends on claim 1, requires the gene delivery vehicle be selected from the group consisting of a nonviral vector, a viral vector, a particulate carrier and a liposome preparation. Claim 12, limits the vehicle to a viral vector selected from a group consisting of a retroviral vector, an adenoviral vector, a poxvirus vector, a picornavirus vector and an alphavirus vector. Claim 13, which depends on claim 12, limits the viral vector to a Sindbis vector, which is an alphavirus vector. Claim 14, which depends on claim 12, limits the viral vector to an alphavirus

¹ Malone et al. U.S. Pat. No. 6110898, filed 05/23/1997.

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selected from a group consisting of Semliki Forest virus, Venezuelan equine encephalitis virus and Ross River virus vector. Claim 16, requires the viral vector be an alphavirus vector that is delivered to antigen presenting cell, which is limited to dendritic cells by claim 17. Claim 19, which depends on claim 1, requires the immune response elicited be HLA class I-restricted, which is limited to a HLA Class II-restricted immune response by claim 20. Claim 21, which depends on claim 1, requires the method of claim 1 to further comprise introducing into target cells of the subject a nucleic acid molecule that encodes at least a protein selected from the group consisting of Class I MHC protein, Class II MHC protein, CD3, ICAM-1, LFA-3. Claims 29-30, which depend on claims 13 and 15, respectively, require the alphavirus vector contained in an alphavirus replicon particle. Claim 35, which depends on claim 1, requires the detoxified toxin be selected from the group consisting of a cholera toxin, a pertussis toxin, and an *E.coli* heat labile toxin. Claims 36-39, which depend on claim 35, limit the toxin to LT-K63, LT-R72, CT-S109 and PT-K9/G129. Claim 41, which depends on claim 1, requires the composition to further comprise a CpG oligonucleotide. Claim 42, which depends on claim 1, requires the vehicle be administered according to a multiple dose schedule.

As established in the previous office action, mailed 09/21/2005, Malone anticipates the claimed invention because Malone et al. discloses a method of inducing a mucosal immune response wherein an antigenic polynucleotide is administered to the vaginal, nasal or rectal mucosal membranes of a subject according to a multiple dose

² O'Hagan et al. U.S. Patent No. 6534064, filed October 10, 2000.

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schedule. [Abstract, lines 2-4; col. 14, lines 64-66; col. 15, lines 57-62; and col. 17, lines 14-17 and 61-63, in particular.] Malone et al. teaches that the antigenic polynucleotide may be derived from a sexually transmitted virus such as HIV-1. [Col. 20, lines 7-10 and 23-25, in particular.] Malone et al. further teaches that the polynucleotide be delivered by an alphaviral vector such as Sindbis or Semliki Forest virus. [Col. 11, lines 39-41, in particular.] The alphavirus vector used by Malone et al. comprises a replicon. [Col. 2, line 66 to col. 3, line 1, in particular.] Malone et al. also discloses introducing a nucleic acid that encodes a Class I and/or a Class II MHC protein. [Col. 4, lines 60-65, in particular.]

The difference between the claimed invention and the disclosure of Malone et al. is: Malone et al. does not teach the administration of a detoxified bacterial ADP-ribosylating toxin, which are adjuvants. However, it should be noted that Malone et al. does teach the use of adjuvants with his replication defective gene delivery vehicle. [Col. 3, line 61 to col. 4, line 3 and 36-47, in particular.] At the cited passage, Malone et al. suggests the use of detoxified bacterial ADP-ribosylating toxin as an adjuvant, including *E. coli* and cholera toxins.

While Malone et al. does suggest the use of an *E. coli* heat labile toxin as an adjuvant, Malone et al. does not teach the following toxins: LT-K63, LT-R72, CT-S109 and PT-K9/G129. However, the deficiency noted of Malone et al. is fully compensated by O'Hagan et al.

O'Hagan et al. teaches LT-K63, LT-R72, CT-S109, PT-K9/G129 and CpG oligonucleotides. O'Hagan et al. teaches the use of these detoxified toxins and CpG oligonucleotides as adjuvants. [Paragraph bridging columns 15-16, in particular.]

Hence, at the time the invention was made, the use of LT-K63, LT-R72, CT-S109, PT-K9/G129 and CpG oligonucleotides as adjuvants are well known in the art. It would have been prima facie obvious for one of ordinary skill in the art, at the time the invention was made, to substitute the adjuvant of Malone et al. with the adjuvants of O'Hagan et al. (K63, LT-R72, CT-S109, PT-K9/G129 and CpG oligonucleotides). At the time the invention was made, one of ordinary skill in the art would have been motivated to do so to enhance the immune response induced by the composition of Malone et al. One of ordinary skill in the art, at the time the invention was made, would have had a reasonable expectation of success for doing so because the substitution of equivalents, adjuvants, are routinely practiced in the art.

It should be noted that Malone et al. inherently discloses presenting an antigenic polynucleotide to dendritic cells. This is necessarily so because mucosal membranes are a natural environment for dendritic cells. Thus, by introducing an antigenic polynucleotide to a mucosal surface, Malone et al. necessarily discloses presenting the antigenic polynucleotide to dendritic cells.

Additionally, as previously noted, Malone et al. inherently teaches eliciting an HLA class I or HLA class II response. This results because Malone et al. teaches administering the antigen-encoding polynucleotide to a human, which would necessarily cause an HLA class I and HLA class II response.

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6. Claims 1, 11-12 and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Malone et al. in view of O'Hagan et al.

Claim 15 requires the alphavirus vector of claim 12, which depends on claim 11, to comprise sequences from two or more alphaviruses.

The significance of Malone and O'Hagan et al., as applied to claims 1 and 11-12 is provided above.

In the instant case, it is noted that neither Malone et al. nor O'Hagan et al. teaches the invention encompassed by claim 15. However, it should be noted that this limitation provides that a sequence from the alphavirus gene delivery vehicle, such as a promoter, may be substituted with a sequence from an alphaviruses of a different serotype. Whether the gene delivery vehicle is derived from one or two alphavirus genomes is immaterial since both embodiments would have similar structure and function. Thus, modifying the gene delivery vehicle of Malone et al. to include a second alphavirus construct would have been obvious to one of ordinary skill in the art, at the time the invention was made. One of ordinary skill in the art, at the time the invention was made, would have been motivated to do so to determine a workable or optimal gene delivery vehicle. One of ordinary skill in the art, at the time the invention was made, would have had a reasonable expectation of success for doing so because substitution of known equivalents are routinely practiced in the art.

Conclusion

7. No claims are allowed.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Le whose telephone number is (571) 272 0903. The examiner can normally be reached on Monday - Friday, 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce R. Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Emily M. Le/
Patent Examiner
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/E.Le/